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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,954	05/03/2001	Sergey Lyusin	0008026-0006	6924

7590

05/08/2002

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EXAMINER

ISSING, GREGORY C

ART UNIT

PAPER NUMBER

3662

DATE MAILED: 05/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/848,954

Applicant(s)

LYUSIN, SERGEY

Examiner

Gregory C. Issing

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 21-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification is insufficiently disclosed with respect to a computer program product and its associated computer readable code to enable a skilled artisan to make and or use the subject matter. The specification fails to make clear how the claimed computer readable code controls the satellites, either GPS or GLONASS, to transmit as each of these sets of satellites are already controlled by the respective governments and are not controllable by user intervention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 21-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 21, the language fails to clearly and distinctly set forth the subject matter which the applicant considers inventive. In line 1, the language sets forth "a computer program product comprising", describes a "computer usable medium" and then again describes the "computer program product comprising". This fails to clearly address the claimed subject matter. It is not clear what the "computer program product" represents since the first portion, lines 2-3, appears

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to describe a position determining program whereas the second portion, lines 4-5, appears to control remote satellites' transmission capabilities (the GPS satellites ?), whereas the third portion, lines 6-7, appears to control a remote station's transmission of information, and whereas the fourth portion, lines 8-9, appears to control a third device for receiving signals from the satellites and station. It is not clear how a single computer product provides these capabilities when the use is by three remote devices.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 1-6, 9, 11-16, 19, 21-26, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor et al.

Taylor et al disclose the claimed system and method including a plurality of satellites 16 configured to transmit signals, a broadcast station antenna 29 configured to transmit an assistance signal and a plurality of receiver terminals 14 configured to receive the satellite signals and the assistance signals. The assistance signals may include, as shown in Figure 2, Doppler data, satellites-in-view data and satellites' position data. In view of the similarity in the claimed

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system and the prior art, the computer program product, as best understood, which could be used to perform the steps of the method are inherent.

7. Claims 1-7, 9-17, 19-27 and 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Krasner.

Krasner discloses the claimed system and method for use in a position determining system including a mobile terminal, as shown by Figure 6A, that receives signals from GPS satellites via antenna 613 and signals from a base station via communication antenna 601 in order determine position with reduced power consumption. The signals from the base station, which is exemplified in Figures 5A and 5B, include Doppler data, identities of satellites in view and/or satellite almanac data. Such data may be derived at the base station or may be obtained from a server site on the Internet. The receiver is suggested to be a 2-way pager or cellular telephone. In view of the similarity in the claimed system and the prior art, the computer program product, as best understood, which could be used to perform the steps of the method are inherent.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Krasner or Taylor et al in view of Richton et al.

Each of Krasner and Taylor et al teach the subject matter substantially as claimed including the provision of satellite signals and assistance signals to a mobile receiver for the

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purpose of determining position. While Krasner suggests the incorporation within a cellular telephone, Taylor et al merely suggest incorporation within a user terminal without being specific. However, each prior art terminal does incorporate a satellite receiver, a communication receiver and a computing processor. Richton et al additionally teach an auxiliary system for providing assistance data to wireless terminals operable for determining position from navigation satellites. Furthermore, Richton et al suggest uses inclusive of cellular telephones and portable data terminals. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify either one of Krasner or Taylor et al by incorporating the position determining system utilizing assistance data in any conventional portable device including cellular telephones or personal data terminals in view of the teachings of Richton et al.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. King et al and Castelloe et al each disclose location determination in a portable communication device that receives satellite signals as well as assistance data from a broadcasting station.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (703)-306-4156. The examiner can normally be reached on Mon-Thurs 6:30-5:00.

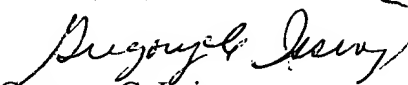
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (703)-306-4171. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9326 for regular communications and (703) 872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.


Gregory C. Issing
Primary Examiner
Art Unit 3662

gci
May 6, 2002